

REMARKS

This Preliminary Amendment has been prepared in response to the Advisory Action mailed January 18, 2000. In the Advisory Action, the Examiner indicated that claims 1-14 were pending in the application and continued to be rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patents 5,664,115 to Fraser and 5,283,731 to Lalonde et al. (References D and B, respectively in the November 26, 1998 Office Action). Claims 2 and 13 have been canceled and thus, claims 1, 3-12 and 14 remain in the case. The Examiner's rejections are traversed below.

Timeline of Prosecution

Applicants would like to provide their own timeline of prosecution which is not quite the same as the timeline of prosecution provided in the January 18, 2000 Advisory Action. In the November 25, 1998 Office Action, Official Notice was relied upon in asserting

that access confirming means for seeking approval for the dealer's access from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required, and access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access is old and well known in the art

(November 25, 1998 Office Action, page 5, lines 5-9). As noted in the January 18, 2000 Advisory Action, the March 25, 1999 Amendment filed in response to the November 25, 1998 Office Action did not request evidence of what was asserted to be old in the art in the quotation above. A request for such evidence was made in the Request for Reconsideration after it was again asserted "that prior approval before browsing information on the network is old and well known in the art" in the last full paragraph on page 4 of the June 7, 1999 Office Action.

The request for evidence supporting the Official Notice was denied in the September 23, 1999 Advisory Action, because "Applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice" (September 23, 1999 Advisory Action, page 3, lines 6-8). This basis for refusing the request for evidence was addressed in a Petition under 37 C.F.R. § 1.181 filed November 8, 1999 requesting that the procedure set forth in MPEP § 2144.03 be followed in

responding to the request made in the September 7, 1999 Request for Reconsideration. Instead of either granting or denying the Petition, the Petition was treated as a second Request for Reconsideration and an Advisory Action was issued on the March 25, 1999 Amendment which refused the request again, this time stating that the reason for refusing the request was that the request for evidence in the September 7, 1999 Request for Reconsideration was "not 'seasonable'" (January 18, 2000 Advisory Action, page 3, line 10). In addition, two U.S. patents and an article by Clinton were cited in the January 18, 2000 Advisory Action, with a sentence or two in each patent cited as relevant.

Newly Cited Prior Art

U.S. Patent 4,953,209 to Ryder, Sr. et al.

The Ryder, Sr. et al. patent is directed to a self-verifying receipt and acceptance system for electronically delivered data objects, such as executable programs. According to the Abstract, a data object is rendered unuseable, e.g., a program is rendered non-executable, prior to being sent to a recipient. A supplemental program is sent with the data object to interact with the recipient and determine whether authorization to use the data object should be granted. The cited portion of Ryder, Sr. et al. (column 1, lines 15-27) describes a drawback of what was prior art when Ryder, Sr. et al. was filed, i.e., that transmission of an encrypted data object to a potential user requires "a previously authorized recipient, or ... prior approval for sending to the recipient" (column 1, lines 20-21). In the prior art it was necessary to have some kind of prior communication or relationship between the sender and the recipient to send a data object in a protected form that the recipient can enable and to assure the sender that the recipient "actually received the data object, agreed to the authorization conditions of its receipt or use and installed it" (column 1, lines 25-27). All prior art techniques were described as requiring "the use of a decrypting key or algorithm which is normally only available to a previously authorized recipient" (column 1, lines 18-20) or requiring "prior approval for sending to the recipient" (column 1, line 21). No mention has been found of how prior approval was obtained in the prior art.

U.S. Patent 6,003,007 to DiRienzo

The DiRienzo patent is directed to a networked computer system for processing dental insurance claims in accordance with the flowchart illustrated in Fig. 2A. The flowchart involves a dental procedure that is paid for by the insurance carrier of the patient only if "prior approval for such treatment" (column 5, line 1) is obtained from the insurance carrier. This approval is obtained on a prior approval claim (PAC) form after the dentist "asks the patient to contact his insurance carrier, or plan administrator at work, to obtain the necessary PAC form" (column 5, lines 4-6). No mention of obtaining approval from a consumer or patient has been found.

Article by Clinton

The article by Clinton is directed to a World Wide Web commerce service which allows users to access sales data generated by "intelligent agents" which "obtain consumers' consent before tracking document browsing and purchasing trends." Very little is disclosed about the service described in the article. It appears that consumer approval is obtained before accumulating information about activities performed by the consumer, rather than before releasing information previously provided by the consumer, as in the case of the present invention.

Rejection under 35 U.S.C. § 103(a)

The January 18, 2000 Advisory Action repeated the rejection under 35 U.S.C. § 103(a) in the June 7, 1999 Office Action of claims 1 and 11-14 as unpatentable over Fraser taken alone and claims 2-10 as unpatentable over Fraser in view of Lalonde et al., in both cases with Official Notice taken "that prior approval before browsing information on the network is old and well known in the art" (June 7, 1999 Office Action, page 4, lines 14-15 and page 5, last two lines).

Applicants submit that the references cited in the January 18, 2000 Advisory Action do not support the assertion that what is recited in the claims was well known when the application was filed. As described above, both Ryder, Sr. et al. and DiRienzo refer to prior approval only with respect to their prior art and Ryder, Sr. et al. does so in discussing previous arrangements between a sender and a receiver of a program, while DiRienzo describes obtaining

third party approval on a document. Only the article by Clinton has anything to do with obtaining approval from consumers and this approval is obtained before acquiring information about the consumer, as opposed to "before the dealer accesses the consumer, when the market information (supplied by the consumer, e.g., in the manner described in Clinton after approval is obtained) has been purchased by the dealer" (claim 1, lines 15-16).

Similar limitations are recited in the other independent claims. Therefore, it is submitted that if the claims continue to be rejected over Fraser and Lalonde et al., more evidence is required to support the Official Notice that has been taken. The Examiner is once again respectfully requested to follow the procedures in MPEP § 2144.03 and cite evidence in support of the Official Notice, or withdraw the rejection.

Furthermore, it is submitted that the present invention is directed to operations that are fundamentally different from those performed by the system taught by Fraser. The system disclosed by Fraser matches sellers of property with potential buyers through a computer network. As illustrated in Fig. 5A, information of the seller is submitted in step S101. Subsequently, as illustrated in Fig. 5B, a property listing is accessed by a potential buyer in step S106. The system then matches sellers and potential buyers in the conventional way where the item sold is described to the buyer first. The present invention, on the other hand first stores "market information about goods which the consumer desires to purchase" (e.g., claim 1, lines 5-6); then, "when the market information has been purchased by the dealer" (claim 1, line 11) the system determines "whether prior approval by the consumer is required" (claim 1, lines 14-15) before the dealer contacts the consumer and, if required, seeks "approval for access by the dealer from the consumer who registered the purchased market information" (claim 1, lines 17-18). There is no suggestion of this series of operations in Fraser and the way approval is obtained in the references cited in the January 18, 2000 Advisory Action do not provide any suggestion of modifying Fraser to perform such operations.

The addition of Lalonde et al. does not overcome the deficiencies of Fraser discussed above. In the June 7, 1999 Office Action, it was acknowledged that "Fraser fails to explicitly teach that the market information has been purchased by the dealer" (June 7, 1999 Office Action, page 5, lines 6-7), but it was asserted that "Lalonde teaches that the consumer is the person who registers the purchased market information (column 3, lines 42-51)" (June 7, 1999

Office Action, page 5, lines 8-9). However, Lalonde et al. discloses creating an advertisement database, comparing profile data to advertisements and generating text output when matches are found. The portion of Lalonde et al. cited in the June 7, 1999 Office Action states that Lalonde et al. applies to "any field in which conventional classified ads are useful" (column 3, lines 50-51) and the examples given involve offering something (including services) for sale or rent, employment "positions available or ... wanted" and "locating persons with specified knowledge or interests." It is not seen how any of these examples apply to "the market information ... (provided by the consumer being) purchased by the dealer" (claim 1, line 11). Since limitations similar to those quoted above from claim 1 are recited in all of the independent claims, it is submitted that claim 1, 3-12 and 14 patentably distinguish over Fraser in view of Lalonde et al. for the reasons set forth above.

Summary

It is submitted that the prior art references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1, 3-12 and 14 are in a condition suitable for allowance. Entry of this Preliminary Amendment, reconsideration of the claims and an early notice of allowance are earnestly solicited.

If any fee is required in connection with the filing of this Preliminary Amendment, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

by: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

700 Eleventh Street, N.W.
Suite 500
Washington, D.C. 20001
Telephone: (202) 434-1500

Dated: 3/16/00